

The opinion in support of the decision entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID C. NELSON

Appeal No. 2003-0503
Application No. 09/687,894

HEARD: JUNE 10, 2003

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 3-15, all the claims currently pending in the application.

Appellant's invention pertains to a balloon weight assembly to be tethered to an inflated balloon in restraint thereof, and more particularly to a balloon weight assembly adapted to provide ballast in various amounts (specification, page 1). A further

understanding of the invention can be derived from a reading of exemplary claims 1, 10 and 15 which appear in Appendix A to appellant's main brief.

The references relied upon by the examiner in support of rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 are:

Metz	5,074,510	Dec. 24, 1991
Gorczyca	6,234,934	May 22, 2001 (filed Jul. 8, 1999)

The following rejections are before us for review:¹

(1) Claims 1 and 3-15, rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

(2) Claims 1, 4 and 8-12, rejected under 35 U.S.C. § 102(b) as being anticipated by Metz.

(3) Claims 3, 5-7, 13 and 14, rejected under 35 U.S.C. § 103(a) as being unpatentable over Metz.

(4) Claim 15, rejected under 35 U.S.C. § 102(e) as being anticipated by Gorczyca.

¹Claims 3-7 depend, either directly or indirectly, from canceled claim 2, the result of an apparent oversight by appellant during prosecution. Since it appears that appellant intended claims 3-5 to depend from claim 1, for purposes of this appeal we will assume this to be the case. Nonetheless, this informality should be corrected upon return of this application to the Technology Center.

Reference is made to appellant's main and reply briefs (Paper Nos. 10 and 13) and to the examiner's final rejection and answer (Paper Nos. 5 and 11) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Rejection (1)

The test for compliance with the second paragraph of 35 U.S.C. § 112 is "whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct." *In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In other words, does a claim reasonably apprise those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The focus in regard to compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, should be whether the claims meet the threshold requirements of clarity and precision (i.e., they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity), not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. Moreover, the circumstance that a claim is broad does not automatically render the claim indefinite. *See, for example, In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

In rejecting the appealed claims under the second paragraph of 35 U.S.C. § 112, the examiner states that claim 1 is indefinite “because the phrase ‘said ballast member being sized to create an interference fit with said cavity’ is inaccurate” (final rejection, page 2). Although not expressly stated, it would appear that the examiner’s criticism of claim 1 also applies to the terminology of independent claim 10 that the ballast member includes a weighted member “sized to create an interference fit within the cavity,” and to the terminology of independent claim 15 that each ballast member is “capable of directly attaching to said cavity.” We understand the examiner’s position in this regard to be that the independent claims on appeal do not satisfy the requirement of the second paragraph of 35 U.S.C. § 112 for definiteness because a “cavity” is an unfilled space within a mass without any surrounding structure and, strictly speaking, a “cavity” (i.e., unfilled space) cannot have an inference fit with another structure.²

Our difficulty with the examiner’s position is that it does not take into account that claim language must be read in light of the supporting specification, and that claim language need only be of such precision to reasonably apprise those of skill in the art of the claim’s bounds. In the present instance, we think that a person of ordinary skill in the art would understand appellant’s claim language, when read in light of the specification, as

²In light of the position taken by the examiner in rejecting the appealed claims under 35 U.S.C. § 112, second paragraph, it is not clear why appellant’s amendment submitted May 9, 2002 (Paper No. 6) offering to clarify the claim language was denied entry.

calling for the ballast member to be sized to create an interference fit (claims 1 and 10), or direct attachment (claim 15), with some part of the material of the body portion that defines the cavity therein. In our view, the examiner's position to the contrary is simply not reasonable.

In light of the above, we will not sustain the examiner's rejection of claims 1 and 3-15 under 35 U.S.C. § 112, second paragraph.

Rejection (2)

Claim 1 calls for a ballast member that is separate and distinct from the body portion, receivable within the cavity of body portion, and sized to create an interference fit with the cavity of the body portion. The examiner contends that the closure member 52 in the Figures 14-16 embodiment of Metz meets these requirements. Appellant does not appear to dispute the examiner's position that closure member 52 of Metz is separate and distinct from the balloon holder 50, and receivable within the cavity formed in the underside of the balloon holder 50. Appellant also does not appear to dispute the examiner's position that closure member 52 is sized to create an interference fit with a wall portion of the cavity of the balloon holder by virtue of the cooperation of pins 57 of the closure member with bosses 56 of the balloon holder. Instead, appellant argues that the examiner erred in the first instance in considering closure member 52 of Metz to be a ballast member. More particularly, appellant argues that the examiner has mischaracterized what is taught by Metz, that the examiner's analysis of Metz is hindsight

driven and not a fair reading of the Metz patent, that the examiner has failed to appreciate that appellant may be his own lexicographer in defining what constitutes a “ballast” as presently claimed, and that Metz does not teach that closure member 52 functions as a ballast member. It is thus apparent that the dispositive issue in regard to the examiner’s anticipation rejection of claim 1 is whether closure member 52 of Metz may be regarded as a “ballast member” within the meaning of that term as used in appellant’s claims.

It is true that the disclosed purpose of appellant’s ballast member is to counterbalance the “lift” of an associated balloon (specification, page 3, lines 24-28), and that the closure member 52 of Metz is disclosed as being for the purpose of containing sand within the cavity formed by the balloon holder 50 and the closure member. However, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference³ or that the reference teach what the applicant is claiming, but only that the claim on appeal “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference.⁴ Moreover, in proceeding before it, the Patent and Trademark Office applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in

³*Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

⁴*Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in appellant's specification.⁵

This guidance from our reviewing court provides the basis upon which we can agree the examiner that the "ballast member" terminology of claim 1 "reads on" the closure member 52 of Metz. More particularly, while appellant's arguments imply that the specification provides a definition of the term "ballast," appellant has not pointed out, and it is not apparent to us, where such definition is to be found. Instead, appellant's specification states at the bottom of page 2 that the ballast member disclosed by appellant "simply provides additional downforce or weight to the balloon weight 10." In that the closure member 52 of Metz necessarily has mass, it unquestionably provides at least some additional downforce or weight to the balloon holder 50. Hence, closure member 52 of Metz inherently acts, at least to some degree, as a "ballast member" within the broad meaning of that term as used by appellant. This is sufficient to anticipate claim 1, notwithstanding appellant's arguments to the contrary that Metz does not "teach" the claimed invention.

For these reasons, we will sustain the examiner's anticipation rejection of claim 1. We also will sustain the examiner's anticipation rejection of claims 4 and 8-12, since appellant has not argued these claims with any reasonable degree of specificity, thereby allowing these claims to fall with claim 1. See *In re Nielson*, 816 F.2d 1567, 1570, 2

⁵*In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

USPQ2d 1525, 1528 (Fed. Cir. 1987) and *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

Rejection (3)

With regard to the examiner's rejection of dependent claims 3, 5-7, 13 and 14 as being unpatentable over Metz, appellant does not expressly challenge the examiner's findings of fact and conclusions of obviousness regarding these dependent claims as set forth on page 4 of the final rejection. In fact, appellant does not contend that these dependent claims recite any additional distinctions over Metz beyond those allegedly found in the base claims from which they depend. Instead, appellant is content with asserting on page 9 of the main brief that these dependent claims are patentable based on their dependency on base claims 1 or 10, whose patentability was argued earlier in the main brief. Such an argument is not tantamount to an argument that these dependent claims are patentable separately of the claims from which they depend. In short, appellant has failed to separately argue the patentability of these dependent claims with any reasonable specificity. They therefore fall with base claims 1 and 10. See *In re Nielson*, 816 F.2d at 1570, 2 USPQ2d at 1528 and *In re Burckel*, 592 F.2d at 1178-79, 201 USPQ at 70.

Rejection (4)

We will not sustain the standing rejection of claim 15 as being anticipated by Gorczyca. Claim 15 requires, among other things, that each of the plurality of weighted

ballast members is capable of “directly attaching” to the cavity defined within the body portion. In Gorczyca, weights 17 are either placed on the tray (see Figures 1, 2, 5 and 6) or in the box (see Figure 4) suspended from the end of the line 13 (col. 5, lines 60-61). Merely placing a weight on (or in) a support, as disclosed by Gorczyca, is not the same as “directly attaching” a weight to a support as called for in appellant’s claim 15. The claim limitation “directly attaching” requires the weight to be fastened or affixed to the support. The loosely fitted or supported weights of Gorczyca are simply not secured to their supports in the manner required by the claim. The circumstance that Gorczyca’s tray-like supports (Figures 1, 2, 5 and 6) include rims 24 and channels 29 for cooperating with the weights to make it less likely that they will fall off the supports does not change our view in this regard.

Accordingly, the rejection of claim 15 as being anticipated by Gorczyca cannot be sustained.

Summary

The rejection of claims 1 and 3-15 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 1, 4 and 8-12 as being anticipated by Metz is affirmed.

The rejection of claims 3, 5-7, 13 and 14 as being unpatentable over Metz is affirmed.

The rejection of claim 15 as being anticipated by Gorczyca is reversed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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